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OPPOSITION NO.: 123,141

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**EXHIBIT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**PUMA AG RUDOLF DASSLER  
SPORT,**

**Opposer,**

**v.**

**MOURAD, SAMIR DBA DON  
REGALON,**

**Applicant.**

)  
) **OPPOSITION NO.: 123,141**  
) **SERIAL NO.: 75/936,519**  
) **MARK: V with Leaping Tiger Design**  
)  
)  
) **OPPOSITION TO OPPOSER'S**  
) **MOTION FOR LEAVE TO AMEND**  
) **NOTICE OF OPPOSITION**  
)  
)  
)

Commissioner for Trademarks  
BOX TTAB  
2900 Crystal Drive  
Arlington, VA 22202-3513



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**OPPOSITION TO OPPOSER'S MOTION FOR LEAVE  
TO AMEND NOTICE OF OPPOSITION**

**I. BACKGROUND**

Applicant filed for its word mark VARESSI on December 2, 1999. The registration subsequently issued on October 23, 2001 as Reg. No. 2,500,926. On March 4, 2000, Applicant filed two related trademark applications: Serial No. 75/936,520 for VARESSI with unique font and leaping tiger design and Serial No. 75/936,519 for V with leaping tiger. On March 11, 2000, applicant then filed for Serial No. 75/942,066 for VARESSI JEANS with tiger head design. Applicant began using the VARESSI word

mark in July of 2000. Concurrent with Applicant's use of the VARESSI word mark, applicant began using the V with leaping tiger design mark and the VARESSI with leaping tiger design mark. All three design marks are reproduced below and appear in Exhibits 2-4.

As can be seen the V in the '519 application mark is the same as the V in the '520 application mark. The leaping tigers in the '519 application mark is the same as the leaping tiger in the '520 application mark. Applicant is obviously attempting to build a family of associated marks. The font in the '066 application is the same as the font used in the '519 and '520 applications. This is designed to build brand recognition.

VARESSI

75/936,520



75/936,519



75/942,066

On November 21, 2000, Applicant's V with leaping tiger mark was published for opposition. On December 14, 2000 Opposer requested and received a 60-day extension of time to file a Notice of Opposition claiming that the time was to be used to investigate the "appropriateness and bases upon which an opposition might be filed." See Exhibit 5, Request for Extension of Time. Opposer had over 90 days in which to evaluate the

“appropriateness and bases” and review its records for similar marks. On February 20, 2001, Opposer, PUMA AG filed Opposition No. 123,141 against Applicant’s registration of Applicant’s mark V with leaping tiger. It is in this matter that Opposer now seeks to amend its Notice of Opposition to add two new causes of action nearly one and one-half years after Opposer’s initial filing date of the opposition. On July 26, 2002, the discovery period closed in this matter.

On April 9, 2002 Applicant’s mark VARESSI with leaping tiger silhouette, Serial No. 75/936,520, depicted above, was published for opposition. Opposer sought sixty-day extension within which to file a Notice of Opposition. On June 10, 2002, Opposer filed a second opposition, Opposition No. 91/152,132, against Applicant for the related mark VARESSI with leaping tiger. This new opposition is equally unmerited and frivolous.

## II. INTRODUCTION

Opposer has filed a Motion to Amend the Notice of Opposition citing the Federal Rules of Civil Procedure, Section 15(a). While the Fed. Rules of Civ. Proc. § 15(a) states that “leave shall be freely given when justice so requires,” Opposer’s present Motion to Amend the Notice of Opposition must be denied because it without merit and is unfair to nonmoving party.

The TTAB is well within its discretion to deny Opposer’s motion to amend. *See Independent Taxicab Operators' Ass'n of San Francisco v. Yellow Cab Co. (of San Francisco)*, 278 F.Supp. 979, (N.D.Cal.1968)(“Leave to amend is within sound discretion of trial court and will be denied where fairness to opposing party so requires”). The TTAB must review the facts and circumstances of each case before granting leave to amend. *See Caddy Imler Creations, Inc. v. Caddy*, 299 F.2d 79, 132 U.S.P.Q. 384 (9<sup>th</sup> Cir. 1962)(“A motion for leave to amend pleadings is addressed to sound discretion of court, and must be decided upon facts and circumstances of each particular case”). *See also, Sackett v. Beaman*, 399 F.2d 884 (C.A.Cal.1968); *Marin County v. U.S.*, 150 F.Supp. 619 (D.C.Cal.1957), reversed on other grounds 78 S.Ct. 880, 356 U.S. 412, 2 L.Ed.2d 879; *Johnson v. Sales Consultants, Inc.*, 61 F.R.D. 369 (D.C.Ill.1973). Through

this Opposition to Opposer's Motion to Amend, Applicant will show that Opposer's Motion to Amend the Notice of Opposition to include the two new causes of action against Applicant is frivolous and unfounded. One of these marks has not been used as a trademark in commerce in the United States prior to Applicant's constructive use and both marks are so clearly non-related to Applicant's mark this claim is frivolous. These claims are being manufactured to burden and overwhelm Applicant through expensive litigation costs, and these two allegedly new marks are clearly unrelated to Applicant's mark. Allowing Opposer to amend its Notice of Opposition will cause irreparable harm and injury to Applicant and must be denied.

### **III. TWO NEW CAUSES OF ACTION ARE FRIVOLOUS**

Opposer's two new causes of action are frivolous and Opposer's Motion to Amend the Notice of Complaint should be denied on this basis. *See Molina v. State of N.Y.*, 956 F.Supp. 257 (E.D.N.Y.1995)("Although leave to amend should be given freely when justice so requires, if a claim is frivolous on its face the court need not permit amendment"). A cause of action is considered "frivolous" when the cause of action is without merit or would not withstand summary judgment. *See Wilson v. American Trans Air, Inc.*, 874 F.2d 386 (C.A.7 (Ind.) 1989)(District court does not abuse its discretion in denying motion to amend when amending pleading would be a futile act; amendment is a "futile gesture" if the amended pleading would not survive a motion for summary judgment"). *See also, Peterson v. Philadelphia Stock Exchange*, 717 F.Supp. 332 (E.D.Pa.1989); *Bruno Wine & Spirits, Inc. v. Guimarra Vineyards*, 573 F.Supp. 337 (E.D.Wis.1983); *Milburn v. Girard*, 441 F.Supp. 184 (D.C.Pa.1977). Opposer alleges that it only recently found two additional marks that it believes would be hurt by Applicant's Registration of Ser. No. 75/936,519 V with leaping tiger. However, at least one of these marks was not used in the United States until after the filing of this Opposition and Applicant's V with leaping tiger mark is not likely to be confused either of the two designs that Opposer submits with its Motion for Amendment. Opposer's new causes of action are without merit and would not survive a motion for summary judgment

by Applicant. The facts surrounding Opposer's allegations prove that these are frivolous claims and Opposer's motion to amend must be denied.

**A. THE LETTER "D" WITH CAT LEAPING IS NOT LIKELY TO BE  
CONFUSED WITH APPLICANT'S "V" WITH LEAPING TIGER.**

Opposer has put forward a new cause of action based on a mark that comprises the letter "D" with a cat leaping through the open portion of the "D". The puma in Opposer's contrived mark does not look anything like the tiger in Applicant's mark. Furthermore, the puma is leaping in the opposite direction as the tiger in Applicant's mark. Most importantly, Opposer does not have the proprietary right to prevent anyone from using a different looking cat in its clothing trademarks with a different looking letter "D" or for that matter a different letter, such as "V" as Applicant has adopted.

There are literally over two hundred live trademarks that incorporate a cat as a trademark in International Class 025. This qualifies under the Du Pont factors as determinative evidence of limiting the right to exclude an applicant from using a particular mark. In re E.I. DuPont DeNemours & Co. clearly enumerated the factors that may be considered when relevant evidence is of record. Under Du Pont, the Board should consider "the number and nature of similar marks in use on similar goods" among the factors to be analyzed. *See In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Given the fact of the multiplicity of cats for clothing registered on the USPTO database, not just a similar cat with a similar mark would be adequate to support confusion. Given the sheer number of cats in use as trademarks, only a near identical cat would be relevant.

A good example of this can be found in Reg. No. 1,983,453, owned by the Detroit Tigers football franchise. The mark consists of the letter "D" with a leaping tiger leaping through the center of the "D". While the "D" is not identical to Opposer's "D" and the leaping cat is not identical, it contains every single element of Opposer's mark. Opposer has no grounds to allege its "D" with leaping puma mark against Applicant when, under its own analysis, it would not be the rightful owner of the mark that Opposer is seeking to use against applicant. Jaguar Cars is another example. Jaguar also uses a cat in their

trademark for the sale of clothing. See Exhibits 10 and 11. The cat appearing in Jaguar Cars Registration Numbers 1,634,877 and 2,286,987 looks more similar to Opposer's mark than Applicant's mark does to Opposer's marks and is leaping in the same direction at the same angle of trajectory. Opposer only has the right to prevent someone from using its design or one that is confusingly similar. Applicant's mark is not confusingly similar. With the distinctiveness of the V for VARESSI in Applicant's mark and the other factors that make Applicant's mark distinctive, there is no possible likelihood of confusion.

Opposer does not have the proprietary right to prevent Applicant from using its selected letter from the alphabet with an animal from the cat family. Even if Opposer's claims are accurate, its only rights are to the letter D with a leaping puma or the letter P with leaping puma or the word mark PUMA with leaping puma or an identical leaping puma. Applicant's use of the letter V with a leaping tiger is part of a family of marks. The letter "V" stands for VARESSI. Similarly, Applicant also uses the word VARESSI in unique font design with the leaping tiger design. The font of the V is the same as the font in VARESSI and the leaping tiger is the same. There is no confusion as to the origin of these products. These are VARESSI products and this is a VARESSI mark.

Opposer's mark comprises the letter "D", initial letter of "DASSLER" as in RUDOLF DASSLER SCHUHFABRIK. There is clearly no likelihood of confusion and no basis for alleging confusion. A comparison of Opposer's mark and Applicant's mark expresses the pronounced difference in the marks and proves that this claim is clearly frivolous. No one would be confused into believing that "V" with leaping tiger was associated with Opposer in light of the multitude of marks using letters and cats, and in light of the mark "D" with leaping puma where the "D" clearly stands for Dassler. See Molina v. State of N.Y., 956 F.Supp. 257 (E.D.N.Y.1995)("Although leave to amend should be given freely when justice so requires, if a claim is frivolous on its face the court need not permit amendment"); See also Joyner v. Abbott Laboratories, 674 F.Supp. 185 (E.D.N.C.1987)("When proposed amendment is frivolous or advances claim or defense that is legally insufficient on its face, motion to amend should be denied"); Slavin v.

Benson, S.D.N.Y.1980, 493 F.Supp. 32; Gunnip v. Warner Co., 43 F.R.D. 365 (D.C.Pa.1968). Opposer's allegation of likelihood of confusion in this new cause of action clearly would not withstand Applicant's Motion for Summary Judgment and therefore must be denied. See Wilson v. American Trans Air, Inc., 874 F.2d 386 (C.A.7 (Ind.) 1989)(District court does not abuse its discretion in denying motion to amend when amending pleading would be a futile act; amendment is a "futile gesture" if the amended pleading would not survive a motion for summary judgment"). See also, Peterson v. Philadelphia Stock Exchange, 717 F.Supp. 332 (E.D.Pa.1989); Bruno Wine & Spirits, Inc. v. Guimarra Vineyards, 573 F.Supp. 337 (E.D.Wis.1983); Milburn v. Girard, 441 F.Supp. 184 (D.C.Pa.1977). Therefore, Opposer's Motion to Amend the Notice of Opposition to add the fourth cause of action comprising the allegation of likelihood of confusion between Applicant's mark and Opposer's mark consisting of the letter "D" with leaping cat mark must be denied.

**B. THE LETTER "P" WITH LEAPING PUMA IS NOT LIKELY TO BE  
CONFUSED WITH APPLICANT'S "V" WITH LEAPING TIGER**

The second cause of action that Opposer seeks to add to the Notice of Opposition is the allegation that Applicant's mark V with leaping tiger will injure Opposer's use of the letter "P" with a puma leaping through the "P". In this cause of action Opposer alleges first use of this design at least as early as June 2001, concurrent with Opposer's filing of this present opposition. However, Applicant's constructive use date is its filing date March 4, 2000, more than a year before Opposer's alleged use. Applicant has made continuous use of its mark V with leaping tiger as embodied in the mark in Application No. 75/936,519 since its first date of actual use of at least as early as July 26, 2000. In Opposer's Amended Notice of Opposition, at Page 2, Paragraph 5, Opposer states that its first use of the P with leaping puma design was "at least as early as June, 2001. By this statement, Opposer admits that its first date of use was after Applicant's constructive use and actual use of its V and leaping tiger mark and therefore this cause of action must be disallowed as frivolous and without merit.

Furthermore, a comparison of Opposer's P mark with leaping puma and Applicant's V mark with leaping tiger will clearly show that there is no likelihood of confusion. Applicant's V with leaping tiger mark does not give the impression of Opposer's P with leaping Puma. Opposer's P clearly stands for PUMA and Applicant's V stands for VARESSI. There can be no confusion about this. The font of the V is identical to the font that Applicant also uses in the design mark of the word VARESSI with the leaping tiger design. The use of the same font is to generate a brand feel and further reinforces that the letter V stands for VARESSI. There is no confusion as to the origin of these products.

As stated earlier, there are literally over two hundred live trademarks that incorporate a cat as a trademark in International Class 025. This qualifies under the Du Pont factors as determinative evidence of limiting the right to exclude an applicant from using a particular mark. In re E.I. DuPont DeNemours & Co. clearly enumerated the factors that may be considered when relevant evidence is of record. Under Du Pont, the Board should consider "the number and nature of similar marks in use on similar goods" among the factors to be analyzed. See In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Given the fact of the multiplicity of cats used as trademark for clothing and registered in the USPTO, not just any cat with a letter would be adequate to support confusion. Given the sheer number of cats in use as trademarks, only a near identical cat used with the same letter would be relevant.

A review of the trademark database reveals that there are over two hundred marks containing a cat with a letter or word. The mark in Reg. No. 1,671,205, owned by the University of Pittsburgh, comprises a leaping cat with the word PITT. See Exhibit 13. The word Pitt is written so that the letter "P" is clearly larger and more pronounced than any other letter in the mark and becomes the center focus of the mark. In comparison with Opposer's design, there is a strong similarity when one abstractly compares the elements. Both have a leaping cat, and both have a prominent letter "P." Opposer does not even have an application for this design, let alone showing actual use of the design as a trademark. There is no confusion between Applicant's "V" with leaping tiger and



Opposer's design comprising a "P" and a leaping puma.

Finally, any of the above arguments with respect to the P with leaping puma design presupposes that the design is a trademark when in fact it is nothing but an ornamental design contrived in bad faith for the purposes of this Opposition. Opposer has supplied no evidence that it has used this P with leaping Puma design as a mark. It has not even offered an example of use of the alleged mark. The photocopy that Opposer provided Applicant appears to be a drawing rather than an actual photograph of products and only shows ornamental use as a decal on the front of the shirt. See Exhibit 9. Opposer has contrived this mark in bad faith to further harm and damage Applicant.

When taken in total context, the claim that Opposer alleges against Applicant with respect to the letter P and leaping Puma is completely without merit and would not withstand summary judgment. Therefore, it is within the Board's discretion and obligation to deny amendment to add this new cause of action. See Ulrich v. City of Crosby, 848 F.Supp. 861 (D.Minn.1994)("Although court begins with presumption of liberality in amendments to pleadings, amendment to pleading can be successfully challenged on grounds of futility if the claims created by the amendment would be unable to withstand motion to dismiss"). Accordingly, amendment of the Notice of Opposition to add Opposer's second new cause of action must be denied.

#### **IV. OPPOSER'S UNREASONABLE DELAY IN BRINGING MOTION UNREASONABLY PREJUDICES APPLICANT**

Opposer has come before the Board to request that the Board allow Opposer to amend its Notice of Opposition to include two new causes of action for "the letter D with leaping puma" and "the letter P with leaping Puma." Applicant opposes this motion on the ground that Opposer has unreasonably delayed in waiting for over one and one-half years after its filing a Notice of Opposition to file this amendment and that allowing such amendment will unduly prejudice Applicants. See Savoy v. White, 139 F.R.D. 265 (D.Mass.1991)("Court may deny amendment to pleadings on grounds of undue prejudice to defendants."). The "court would not abuse its discretion in refusing to permit

amendment of complaint where it would be futile or would prejudice other party.” Resolution Trust Corp. v. Jet Stream, Ltd., 790 F.Supp. 1130 (M.D.Fla.1992). As shown in Section III above, the amendments would not likely survive a Motion for Summary Judgment and are effectively meritless.

Equally as important, Opposer had ample time review its marks prior to filing its original Notice of Opposition on February 20, 2001. In the interim since filing the Opposition, Applicant has already stipulated to allowing Opposer to amend its Notice of Opposition once with respect to its faulty pleading of a wrong trademark number. Now Opposer comes forth, over one and one-half years after filing its Opposition, and at the close of discovery, to file this Motion to Amend the Notice of Opposition by filing two new causes of action against Applicant. This motion must be denied on the basis of its unreasonable delay and bad faith surrounding Opposer’s allegations. Quaker State Oil Refining Corp. v. Garrity Oil Co., Inc., 884 F.2d 1510 (C.A.1 (Mass.) 1989 )(While leave to amend shall be freely given when justice so requires, party seeking benefit of rule's liberality has obligation to exercise due diligence; unseemly delay, in combination with other factors, may warrant denial of suggested amendment). Opposer has waited so long because these two new marks were not used in commerce in the United States and now attempts to plead it in the Notice of Opposition in an attempt to overwhelm the resources of a legitimate user of an unrelated mark.

If, as Opposer alleges, these alleged marks were used prior to Applicant’s use of it V with leaping tiger mark in Applicant’s application, then Opposer should have known about the marks when it filed its Notice of Opposition. Opposer states on page 2 of its motion that “As a direct result of searching through documents to provide the discovery requested by Applicant, counsel for Opposer learned that Opposer had adopted and used on goods in International Class 25 a mark consisting of the letter “D” with a cat silhouette leaping through the letter “D”.” There was never any mention to Applicant of these alleged discoveries prior to seeking to amend the Notice of Opposition. Furthermore, this alleged discovery was not provided to Applicant until Opposer sought to amend its Notice of Opposition. In addition, Opposer admits that the letter “P” with leaping puma

mark was not used until June 2001, more than one year after Applicant's constructive use of the V with leaping tiger.

Through its actions and words, it is apparent that Opposer seeks to drive up costs and overwhelm Applicant by burying him in the expense of defending this Opposition, these new unmerited causes of action and a recently filed second opposition against the mark VARESSI with leaping tiger, Opposition No. 91,152,132. This is all an attempt to block Applicant's legitimate use of legitimate marks. This amendment will cause applicant the enormous burden of defending Opposer's unmerited allegations and filing for summary judgment. Opposer knew or should have know the breadth and scope of its own catalog of marks when it filed this Opposition proceeding. Opposer's counsel has been Opposer's litigation counsel of record for several years, bringing numerous actions before the Board against numerous Applicants. Opposer and Opposer's counsel should have known of the alleged marks that it seeks to amend into this Notice of Opposition at the time it filed it.

If Opposer did not know of its own marks at the time of filing the Opposition on February 20, 2001 after having had 90 days after the Applicant's publication to review the "appropriateness and bases upon which an opposition might be filed," then the marks must not have been used in the United States at the time of filing the Opposition and have no place as subject matter in the present opposition. If Opposer knew of the marks, they should be estopped from alleging these marks now because they are merely an attempt to overwhelm the Applicant's financial resources. *See Dow Corning Corp. v. General Elec. Co.*, 461 F.Supp. 519, 202 U.S.P.Q. 781 (N.D.N.Y.1978)(The District Court held in an analogous situation in a patent infringement action, plaintiff's motion to amend complaint to include allegations as to reissue patent would be denied where plaintiff had had knowledge of facts upon which proposed amendment was based but failed to include them in original complaint and where amendment would impose additional burdens of costs and delay relating to further discovery by defendant). This delay and bad faith require the Board to deny Opposer's Motion to Amend the Notice of Opposition.

**V. OPPOSER'S BAD FAITH INTENT IN BRINGING THESE ADDITIONAL CLAIMS IS TO DRIVE UP COSTS AND DAMAGE APPLICANT'S FINANCES**

Opposer is using these proceedings in an improper manner and in bad faith in an attempt to drive up costs and damage Applicant by forcing it to respond to unmeritorious claims in this and other similar proceedings. The Board is justified in denying Opposer's Motion to Amend the Notice of Opposition on the grounds of bad faith because of Opposer's improper use of governmental process. *See Merrill Lynch Business Financial Services Inc. v. Plesco, Inc., 859 F.Supp. 818 (E.D.Pa.1994)*(Bad faith is proper ground upon which to deny a party leave to amend complaint). These additional causes of action will require extensive discovery to defend. Opposer has failed to provide significant amounts of discovery that Applicant has sought and these two new meritless causes of action will require Applicant to engage in further discovery practice and in likely motions to compel. Opposer offers only one month to perform discovery on two new causes of action, when it is likely that Opposer will not even respond in the time provided.

Furthermore, this is not the only bad faith act committed by Opposer in an attempt to damage Applicant. On June 10, 2002 Opposer filed a second opposition action against Opposer's VARESSI with leaping tiger mark, Serial No. 75/936,520. This opposition has been assigned Opposition No. 91/152,132. Opposer alleges the same likelihood of confusion based on the same marks as in this present Opposition. This new opposition is frivolous and is merely an attempt by Opposer to damage Applicant's finances through frivolous litigation.

Opposer has filed this initial cause of action against Applicant to damage him and block his legitimate use of his V with leaping tiger mark. Opposer has filed the second opposition action to financially ruin Applicant in an attempt improperly appropriate Applicant's rights to use the V with leaping tiger mark. This is an abuse of governmental process to damage an innocent defendant. By its very nature, the massive litigation muscle that Opposer, the multinational corporation PUMA AG RUDOLF DASSLER, can mount against an individual entrepreneur to prevent him from legitimately using his

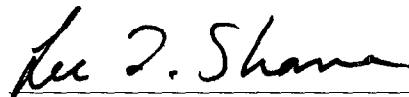
mark is bad faith and unfair. The Board should deny leave to amend where it will damage the opposing party and is against the interests of fairness. See Independent Taxicab Operators' Ass'n of San Francisco v. Yellow Cab Co. (of San Francisco), 278 F.Supp. 979 (N.D.Cal.1968) ("Leave to amend is within sound discretion of trial court and will be denied where fairness to opposing party so requires"). Taken in its totality, Opposer's Motion to Amend the Notice of Opposition to add frivolous and unmeritorious causes of action is in bad faith and unfair to Applicant and must be denied.

## VI. CONCLUSION

Opposer has requested the Board grant leave for Opposer to amend the Notice of Opposition to add two new causes of action. Applicant has shown that the two new causes of action are frivolous and would not survive a motion for summary judgment. Applicant has shown that Opposer has engaged in bad faith in unreasonably delaying in bringing this motion when it had ample opportunity during the one and one-half years since filing the notice of opposition. Finally, Applicant has shown that Opposer has acted in bad faith by attempting to financially overwhelm Applicant in order to appropriate Applicant's rightful use of its applied for marks. Under these factors individually and in their totality, Opposer's Motion to Amend the Notice of Opposition to add two new causes of action must be denied.

Respectfully Submitted,  
TROJAN LAW OFFICES  
by

Dated: Aug. 6, 2002



R. Joseph Trojan  
Lee Fredric Sharra  
TROJAN LAW OFFICES  
9250 Wilshire Blvd., Suite 325  
Beverly Hills, CA 90212  
(310) 777-8399  
Attorneys for Applicant  
Samir Mourad dba Don Regalon